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Remarks*Claim Rejections - 35 USC § 112*

The Examiner has rejected Claims 1, 7, and 12 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner states that Claim 1 is confusing because based on claim 7, it appears that components A and B may be identical, that is, carboxylate esters. Accordingly, it is impossible to tell which portion of an ester component may serve as component A and which part will serve as component B.

Claim 7, which depends from Claim 6 requires that the component (B) is a glycerol mono- or di-ester of a carboxylic acid having 8 to 30 carbon atoms and contains unesterified -OH groups which are more polar than the carboxylate ester groups of polyol ester (A). By definition, if the glycerol mono- or di-ester of a carboxylic acid having 8 to 30 carbon atoms contains unesterified -OH groups which are more polar than the carboxylate ester groups of polyol ester (A), it must differ from Component (A). Furthermore, Applicants have amended Claim 1 to recite that for a diol or a triol at least 90% of the hydroxyl groups of the polyol are esterified, and for higher polyols at least 70% of the hydroxyl groups of the polyol are esterified. Applicants therefore believe it is clear to one skilled in the art that Components (A) and (B) cannot be identical.

The Examiner states that Claim 7 is confusing because it requires component B to be an ester, however, claim 6, from which claim 7 depends, requires component B to contain "unesterified -OH groups".

For the reasons stated above, Applicants do not believe Claim 7 to be confusing.

In claim 12, it is not clear which component, A or B has the amide or amino groups. This claim should be rewritten for clarity.

Applicants have amended Claim 12. Applicants believe this amendment clarifies which Component contains the amide or amino groups.

For the above reasons, the applicants believe that they have particularly pointed out and distinctly claimed the subject matter that they regard as their invention. Therefore, the applicants request that the rejection under 35 U.S.C. §112, second paragraph, be withdrawn and the claims allowed to issue.

Claim Rejections - 35 USC § 102

The Examiner has rejected Claims 1, 5-7, 11, and 18 under 35 U.S.C. 102(b) as being anticipated by Cella et al, US 4,272,544. The Examiner states that Cella et al teach a skin lotion comprising 3% polyphenylmethylsiloxane, 2% glyceryl monostearate, 2% sorbitan monostearate, 1% ethylene glycol monostearate, 1.7% polyoxyethylene (30) stearate, which is an ethoxylated alcohol, and the balance water (col. 8, lines 30-48). The Examiner further states that this reference meets all material limitations of the claims at hand, and that therefore the reference is anticipatory.

Cella et al. fails to disclose the foam control composition as now recited in Claims 1, 5-7, 11, and 18. Nowhere in Cella et al. is a foam control composition comprising a polydiorganosiloxane fluid, a hydrophobic filler dispersed in the polydiorganosiloxane fluid, and the additive composition of Claim 1 and claims depending therefrom disclosed or taught. Furthermore, nowhere in Cella is it taught that Component (A) as recited in Claim 1, is required to be miscible with a component (B) and that said Component (B) is more polar than Component (A).

Therefore, the applicants request that the rejection under 35 U.S.C. §102(b) be withdrawn and the claims allowed to issue.

The Examiner has also rejected Claims 1-3, 5, 7, 11, 13, and 17-20 under 35 U.S.C. 102(b) as being anticipated by Yamada et al, US 4,719,034.

The Examiner states that Yamada et al teach a solid silicone defoaming agent comprising 30% of a silicone composition consisting of finely divided silica and a dimethylsiloxanemethyltetradecylsiloxane-methyl(2-phenylethyl)siloxane copolymer, 30% glyceryl monostearate, and 20% propylene glycol monostearate (col. 6, example 3). The

Examiner further states that this reference meets all material limitations of the claims at hand, the reference is anticipatory.

Yamada et al. fails to disclose the foam control composition as now recited in Claims 1-3, 5, 7, 11, 13, and 17-20. Nowhere in Yamada et al. is a foam control composition comprising a polydiorganosiloxane fluid, a hydrophobic filler dispersed in the polydiorganosiloxane fluid, and the additive composition of Claim 1 and claims depending therefrom disclosed or taught. Furthermore, nowhere in Yamada et al. is it taught that when Component (A) as recited in Claim 1, is a diol or a triol at least 90% of the hydroxyl groups of the polyol are esterified, and that when Component (A) is a higher polyol at least 70% of the hydroxyl groups of the polyol are esterified. Furthermore, nowhere in Yamada et al. is it disclosed that Component (A), a non-polar polyol ester is required to be miscible with a component (B) and that said Component (B) is more polar than Component (A).

Therefore, the applicants request that the rejection under 35 U.S.C. §102(b) be withdrawn and the claims allowed to issue.

The Examiner has also rejected Claims 1, 5-7, 11, 13, 14, 17, and 18 under 35 U.S.C. 102(b) as being anticipated by O'Laughlin et al, US 4,868,169. The Examiner states that O'Laughlin et al teach a skin cream comprising up to 2% polydimethylsiloxane or polyphenylmethylsiloxane, up to 13% glyceryl monostearate, up to 7% polysorbate 60, which is an ethoxylated alcohol, micronized powder, and a wax thickener (col. 4, lines 35-53). The Examiner notes that paraffin wax is a suitable thickener of the invention (col. 3, lines 15-23). The Examiner further states that as this reference meets all material limitations of the claims at hand, the reference is anticipatory.

O'Laughlin fails to disclose the foam control composition as now recited in Claims 1, 5-7, 11, 13, 14, 17, and 18. Nowhere in O'Laughlin is a foam control composition comprising a polydiorganosiloxane fluid, a hydrophobic filler dispersed in the polydiorganosiloxane fluid, and the additive composition of Claim 1 and claims depending therefrom disclosed or taught. Furthermore, nowhere in O'Laughlin is it taught that Component (A) as recited in Claim 1, is required to be miscible with a component (B) and that said Component (B) is more polar than Component (A).

Therefore, the applicants request that the rejection under 35 U.S.C. §102(b) be withdrawn and the claims allowed to issue.

The Examiner has rejected Claims 13 and 14 under 35 U.S.C. 102(e) as being anticipated by Schmid et al, US 6,610,752. The Examiner states that Schmid et al teach defoamer granules comprising polydimethylsiloxane, microfine silanized silica, paraffin, and bis-stearyl ethylenediamide (col. 28, example 6). The Examiner further states that as this reference meets all material limitations of the claims at hand, the reference is anticipatory. The Examiner notes that the silicone fluid of claim 13 is satisfied by polydimethylsiloxane, an extremely common defoamer in the art.

Schmid et al. fails to disclose the foam control composition as recited in Claims 13 and 14. Nowhere in Schmid et al. is a foam control composition comprising a polydiorganosiloxane fluid, a hydrophobic filler dispersed in the polydiorganosiloxane fluid, and the additive composition of Claim 1 and claims depending therefrom disclosed or taught. Furthermore, nowhere in Schmid et al. is it disclosed that Component (A), a non-polar polyol ester is required to be miscible with a component (B) and that said Component (B) is more polar than Component (A).

Therefore, the applicants request that the rejection under 35 U.S.C. §102(b) be withdrawn and the claims allowed to issue.

The Examiner has also rejected Claims 1, 5-7, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Minami et al, WO 01/39733 (US 6,890,543 for English translation). Minami et al teach a lipstick comprising 2% glyceryl diisostearate, 10% silicone resin, 1% ethoxy/propoxy alcohol, and 2% methylphenylpolysiloxane (col. 10, example 21). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

Minami et al. fails to disclose the foam control composition as now recited in Claims 1, 5-7, and 15. Nowhere in Minami et al. is a foam control composition comprising a polydiorganosiloxane fluid, a hydrophobic filler dispersed in the polydiorganosiloxane fluid, and the additive composition of Claim 1 and claims depending therefrom disclosed or taught. The additive composition has a melting point of at least 35°C and therefore is a solid. The glyceryl

diisostearate cited by the Examiner would not meet this criteria. Thus Minami et al. does not disclose a material which would fall within the scope of the description of Component (A) as recited in Claim 1. Furthermore, nowhere in Minami et al. is it disclosed that Component (A), a non-polar polyol ester is required to be miscible with a component (B) and that said Component (B) is more polar than Component (A).

Therefore, the applicants request that the rejection under 35 U.S.C. §102(b) be withdrawn and the claims allowed to issue.

Claim Rejections - 35 USC § 103

The Examiner has rejected Claims 1, 4-14, and 17-20 under 35 U.S.C. 103(a) as being unpatentable over Schmid et al, US 6,610,752. The Examiner states that Schmid et al is relied upon as set forth above. The Examiner states that suitable organopolysiloxanes of the invention may have as their substituents, methyl, ethyl, propyl, butyl, and phenyl (col. 2, lines 34-43). The Examiner further argues that besides silicones, other defoamers for use in the invention include the mono, di, or triesters of glycerol (col. 4, lines 64-67). Note that these granules are added to detergents which may contain well known nonionic surfactants such as ethoxylated alcohols and ethoxylated alkyl phenols (col. 9, lines 40-67). The Examiner also states that Schmid et al do not specifically teach a combination of silicone defoamers and mixtures of glycerol esters, however, as these esters are specifically taught as well known defoamers, it would have been obvious to one of ordinary skill in the art to formulate a defoaming granule incorporating these esters with a reasonable expectation of enhancing its defoaming efficacy.

As stated above, Schmid et al. fails to disclose the foam control composition as recited in Claims 1, 4-14, and 17-20. Nowhere in Schmid et al. is a foam control composition comprising a polydiorganosiloxane fluid, a hydrophobic filler dispersed in the polydiorganosiloxane fluid, and the additive composition of Claim 1 and claims depending therefrom disclosed or suggested. Furthermore, nowhere in Schmid et al. is it suggested that Component (A), a non-polar polyol ester is required to be miscible with a component (B) and that said Component (B) is more polar than Component (A). Nowhere is such a combination of Components suggested or contemplated.

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To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure MPEP §2143.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art MPEP §2143.03. All words in a claim must be considered in judging the patentability of that claim against the prior art MPEP §2143.03. If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious MPEP §2143.03. The Examiner has not shown that all the claim limitations in Claims 1 and 13, and Claims depending therefrom, are taught or suggested in Schmid et al.

Therefore, the applicants request that the rejection under 35 U.S.C. §103 be withdrawn and the claims allowed to issue.

The Examiner has also rejected Claims 1-3, 5-7, 9-11, 13-15, and 17-20 under 35 U.S.C. 103(a) as being unpatentable over Dickinson, GB 1,523,957. The Examiner states that Dickinson teaches a foam control substance comprising a stearyl alcohol ethoxylate, silica, and a polydiorganosiloxane with mixed organic groups, wherein the organic groups are methyl, ethyl, and phenyl propyl, and the foam control substance is adhered to granular sodium tripolyphosphate (page 3, example 1). The Examiner states that suitable organic groups of the invention include octyl, tetradecyl, and phenyl (page 1, lines 41-44) and suitable additives of the invention include silicone resin copolymers, microcrystalline wax, and the esters of fatty acids with polyhydric alcohols, such as glycerol monostearate (page 2, lines 15-26). The Examiner further states that Dickinson does not specifically teach a combination of the polydiorganosiloxane fluid and polyol esterified carboxylate presently claimed, however, as these esters are taught as preferred emulsifiers of the invention, it would have been obvious to one of ordinary skill in the art to incorporate an ester into

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example 1 and so satisfy the material limitations of the claims at hand.

GB 1,523,957 fails to disclose the foam control composition as recited in Claims 1-3, 5-7, 9-11, 13-15, and 17-20. Nowhere in GB 1,523,957 is a foam control composition comprising a polydiorganosiloxane fluid, a hydrophobic filler dispersed in the polydiorganosiloxane fluid, and the additive composition of Claim 1 and claims depending therefrom disclosed or suggested. Furthermore, nowhere in GB 1,523,957 is it suggested that Component (A), a non-polar polyol ester is required to be miscible with a component (B) and that said Component (B) is more polar than Component (A).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure MPEP §2143.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art MPEP §2143.03. All words in a claim must be considered in judging the patentability of that claim against the prior art MPEP §2143.03. If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious MPEP §2143.03. The Examiner has not shown that all the claim limitations in Claims 1 and 13, and Claims depending therefrom, are taught or suggested in GB 1,523,957.

Furthermore, the Examiner is directed to Comparative Example C2 and Examples 1-5 and to the results in Table 1 on page 19 of Applicants' specification. It is clear from the data presented therein, the using glycol monostearate (GMS) alone was not as effective in defoaming performance as compared to Examples 1-5 where GMS was used in combination with a non-polar polyol ester (A) which is a polyol esterified by carboxylate groups each having 7 to 36 carbon atoms, wherein for a diol or a triol at least 90% of the hydroxyl groups of the polyol are

esterified, and for higher polyols at least 70% of the hydroxyl groups of the polyol are esterified (i.e. glyceryl tristearate (GTS)).

Therefore, the applicants request that the rejection under 35 U.S.C. §103 be withdrawn and the claims allowed to issue.

The Examiner has also rejected Claims 1-3, 5-7, 9-11, 13-20 under 35 U.S.C. 103(a) as being unpatentable over L'Hostis et al, EP 1,075,863. The Examiner states that L'Hostis et al teach a silicone foam control substance comprising an organic fluid, a siloxane resin containing MQ groups, a silica filler having a particle size of from 0.5 to 30 microns, a particulate carrier, and a mixture of polydiorganosiloxanes, wherein at least one of the organic groups is a phenylpropyl group (page 10, claims 1-4, 10, 15, and 24). The Examiner further states that suitable nonionic surfactants of the invention include ethoxylated alcohols and esters of glycerol (page 6, lines 30-35). L'Hostis et al do not specifically teach a combination of the polydiorganosiloxane fluid and polyol esterified carboxylate presently claimed, however, as these esters are taught as suitable nonionic surfactants of the invention, it would have been obvious to one of ordinary skill in the art to incorporate an ester into claim 1 and so satisfy the material limitations of the claims at hand.

L'Hostis fails to disclose the foam control composition as recited in Claims 1-3, 5-7, 9-11, and 13-20. Nowhere in L'Hostis is a foam control composition comprising a polydiorganosiloxane fluid, a hydrophobic filler dispersed in the polydiorganosiloxane fluid, and the additive composition of Claim 1 and claims depending therefrom disclosed or suggested. Furthermore, nowhere in L'Hostis is it suggested that Component (A), a non-polar polyol ester is required to be miscible with a component (B) and that said Component (B) is more polar than Component (A). Nowhere in L'Hostis is a material which would fall within the definition of Component (A) suggested or contemplated.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the

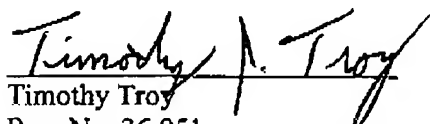
reasonable expectation of success must both be found in the prior art, not in applicant's disclosure MPEP §2143.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art MPEP §2143.03. All words in a claim must be considered in judging the patentability of that claim against the prior art MPEP §2143.03. If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious MPEP §2143.03. The Examiner has not shown that all the claim limitations in Claims 1 and 13, and Claims depending therefrom, are taught or suggested in L'Hostis.

Therefore, the applicants request that the rejection under 35 U.S.C. §103 be withdrawn and the claims allowed to issue.

Applicants also submit herewith a petition for extension of time. You are authorized to charge deposit account 04-1520 for any fees necessary to maintain the pendency of this application. You are authorized to make any additional copies of this sheet needed to accomplish the purposes provided for herein and to charge any fee for such copies to deposit account 04-1520.

Respectfully Submitted,
Dow Corning Corporation


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